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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,412	12/14/2001	Naohiro Furukawa	HITA.0132	9775
38327	7590	06/10/2004	EXAMINER	
REED SMITH LLP 3110 FAIRVIEW PARK DRIVE, SUITE 1400 FALLS CHURCH, VA 22042			BACKER, FIRMIN	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/014,412

Applicant(s)

FURUKAWA, NAOHIRO

Examiner

Firmin Backer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2001.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-20 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☒ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) ☐ Notice of Informal Patent Application (PTO-152)
 6) ☐ Other: _____.

DETAILED ACTION

This is in response to a letter for patent filed on December 11th, 2001 in which claims 1-20 are presented for examination. Claims 1-20 are pending in the letter.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 1 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
6. The basis of this rejection is set forth in a two prong test of:
 - (1) whether the invention is within the technological arts; and

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(2) whether the invention produces a useful, concrete and tangible result.

For a claimed to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" and therefore are found to be non-statutory subject matter. For a method claim to pass the muster, the recited method must somehow apply, involve, use, or advance the technological arts.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Alley et al (U.S. PG Pub No. 20030078880).

9. As per claim 1, 2 and 9, Alley et al teach a method for providing a document along with document processing information thereby processing the document according to the document processing information by embedding the document processing information in the document (*see abstract, figs 2, paragraphs 0015-0018, 0046*).

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10. As per claim 3, Alley et al teach a document processing information is encoded in the document (*see abstract, figs 2, paragraphs 0015-0018, 0046*).
11. As per claim 4, Alley et al teach a document transmitted through paper delivery, a communication medium, or a telecommunication medium (*see fig 1*).
12. As per claim 5, Alley et al teach a document processing information includes operational information including at least one document handling procedure (*see figs 2, 3*).
13. As per claim 6, Alley et al teach a document procedure is a document cutting step in conjunction with a document cutting position, a seal stamping step in conjunction with a seal stamping position, a document identification step in conjunction with a document ID, a document format identification step in conjunction with a document format ID, an encryption step in conjunction with a encryption key, or a decryption step in conjunction with a decryption key (*see abstract, figs 2, paragraphs 0015-0018, 0046*).
14. As per claim 7, Alley et al teach a document wherein said document processing information is in at least one of such forms as a two-dimensional bar code, text, an one-dimensional, two-dimensional, or three-dimensional bar code, a logo mark, a photograph, a graphic, a watermark, a holographic, a magnetic tape, or an IC chip (*see abstract, figs 2, paragraphs 0015-0018, 0046*).

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15. As per claim 8, Alley et al teach a document wherein the document is a bill for payment or a commercial paper (*see abstract, figs 2, paragraphs 0015-0018, 0046*).

16. As per claim 10, Alley et al teach a document processing system comprising: input means for reading an embedding medium on a document; document processing information extracting means for extracting document processing information embedded in the embedding medium; and document processing means for executing the document processing information which includes at least one document handling procedure (*see abstract, figs 2, paragraphs 0015-0018, 0046*).

17. As per claim 11, Alley et al teach a document wherein the input means includes an image input means for reading a document image (*see abstract, figs 2, paragraphs 0015-0018, 0046*).

18. As per claim 12, Alley et al teach a document processing system wherein the document processing means executes the document handling procedure by reading character strings stated on the document in accordance with the document processing information (*see abstract, figs 2, paragraphs 0015-0018, 0046*).

19. As per claim 13, Alley et al teach a document processing system wherein document is a bill for payment or a commercial paper (*see abstract, figs 2, paragraphs 0015-0018, 0046*).

20. As per claim 14, Alley et al teach a document processing system further comprising: an embedding medium identification means for identifying whether any embedding medium

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embedded with the document processing information is on the document; and document processing information database retrieving means for retrieving a set of document processing information from a document processing information database of a document provider so as to assign the set of document processing information to the document, if the embedding medium identification means does not identify any embedding medium embedded with the document processing information on the document (*see abstract, figs 2, paragraphs 0015-0018, 0046*).

21. As per claim 15, Alley et al teach a document processing system wherein said database is stored in the document processing system or in a network to which said document processing system is linked (*see abstract, figs 2, paragraphs 0015-0018, 0046*).

22. As per claim 16, Alley et al teach a document processing system further comprising a document processing information defining means for defining a new set of document processing information to be applied to the document if the retrieving means can not retrieve any set document processing information in the database of the document provider (*see abstract, figs 2, paragraphs 0015-0018, 0046*).

23. As per claim 17, Alley et al teach a document processing system wherein the set of document processing information is selected from the database based upon a degree of similarity between a document format associated with the set of document processing information and a document image entered through an image input means (*see abstract, figs 2, paragraphs 0015-0018, 0046*).

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24. As per claim 18, Alley et al teach a document processing system wherein the system notifies the document provider the newly-defined set of document processing information so as to be included in the database or to be embedded in other document by the document provider (*see abstract, figs 2, paragraphs 0015-0018, 0046*).

25. As per claim 19, Alley et al teach a document processing system comprising a document processing charge billing means for differentiating charges billed to the document issuer according to whether document processing information is stored on the document (*see abstract, figs 2, paragraphs 0015-0018, 0046*).

26. As per claim 20, Alley et al teach a document generating software product, comprising: a communication module for enabling a prospective document user wishing to have a document made to notify a document generator of requirements regarding a desired document layout and a desired document handling procedure; a document layout making module for making a document layout according to the requirements from said prospective document user; a document candidate presenting module for presenting to the prospective document user document candidates made by the document layout making module; a document selecting module for letting the prospective document user select a document out of the document candidates presented by the document candidate presenting module; and a document processing information embedding module for enabling said document generator to embed document

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processing information onto the selected document candidate itself (*see abstract, figs 2, paragraphs 0015-0018, 0046*).

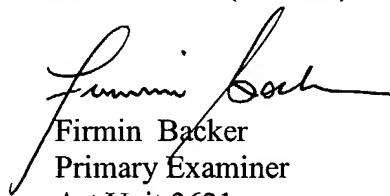
Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (*see form 892*).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Firmin Backer
Primary Examiner
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May 26, 2004